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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,676	07/14/2003	Frederic Legrand	05725.1227-00	4116
22852	7590	09/05/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER AHMED, HASAN SYED	
			ART UNIT 1618	PAPER NUMBER
			MAIL DATE 09/05/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/617,676

**Applicant(s)**

LEGRAND, FREDERIC

**Examiner**

HASAN S. AHMED

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 23-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of applicant's remarks, filed on 5 June 2008.

\* \* \* \* \*

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dias (U.S. Patent No. 6,540,791) in view of Legrand, et. al. (U.S. Patent No. 6,260,556), further in view of Caes, et. al. (U.S. Patent No. 6,423,306).

Dias teaches a hair bleaching composition and a method of making a hair bleaching composition comprising the polydecene of instant claims 1, 3-5, 18, and 21 (see col. 23, line 12), the nonionic amphiphilic polymers of instant claim 16 (see col.15, lines 37-48), the peroxygentated salt (perborate) of instant claim 10, the alkaline agent (ammonium salts) of instant claims 13 and 14, and the surfactants of instant claim 17 (see col. 9, lines 52-59). The composition may be in the paste form of instant claims 1, 18, and 21 (see col. 49, line 36).

Dias explains that by combining the disclosed ingredients into one composition, "...stable hair bleaching and/or coloring compositions can be made which are safe and effective for use on mammalian hair and which provide ... (increased) shelf-life and bleaching effect benefits..." See col. 3, lines 34-38.

The Dias reference differs from the instant application in that it does not disclose the particular peroxygenated salts of instant claim 11 or the hydrogen peroxide of instant claims 21 and 22.

Legrand, et. al. teach anhydrous compositions for bleaching keratin fibers (see col. 1, lines 1-13). The disclosed composition consists of, *inter alia*, the sodium persulphate of instant claim 11 (see col. 17, line 6), and hydrogen peroxide (see col. 1, line 19).

The Dias reference differs from the instant application in that it does not disclose the polydecene of claims 1, 3, 18, and 20-22, in which at least 30 carbon atoms are presented in the claimed formula.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a composition by incorporating a polydecene compound having at least 30 carbon atoms because the Dias reference teaches clearly that polydecene compounds having more than 19 carbon atoms can be used in the composition (see col. 23, lines 1-12). Thus, a person of ordinary skill in the art would be motivated to use hydrocarbon polymers having more than 19 carbon atoms, including those claimed, and would expect such a composition to have similar properties to those claimed, absent unexpected results.

The Dias reference differs from the instant application in that it does not disclose the gelling agent of instant claims 1, 6-9, 18, 21 and 22.

Caes, et. al. teach cosmetic compositions for use on hair, including pastes (see col. 5, line 60; col. 6, lines 30-39).

The disclosed composition consists of the gelling agent of instant claims 1, 6-9, 18, 21 and 22, including the particular hydrogenated block copolymers of instant claim 9.

Caes, et. al. explain that use of multi-block copolymers in a cosmetic composition provides the benefits of, "...very good adherence to the substrate, flexibility, wearability, good dry time, non tacky, good retention, non transfer, and low migration over time." See col. 1, lines 53-56.

While the Dias reference does not explicitly teach all the instant claimed percentages of agents, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable percentages through routine or manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art.

Moreover, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456; 105 USPQ 233, 235 (CCPA 1955). Applicants have not demonstrated any unexpected or unusual results, which accrue from the instant percentage ranges.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to make an anhydrous paste comprising a peroxygenated salt, an

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alkaline agent, a polydecene, and a gelling agent, as taught by Dias in view of Legrand, et. al., further in view of Caes, et. al.

One of ordinary skill in the art at the time the invention was made would have been motivated to make an anhydrous paste comprising a peroxygenated salt, an alkaline agent, a polydecene, and a gelling agent for the beneficial effects of stable hair bleaching and/or coloring compositions which are safe and effective for use on mammalian hair and which provide increased shelf-life and bleaching effect benefits, as well as very good adherence to the substrate, flexibility, wearability, good dry time, non tacky, good retention, non transfer, and low migration over time, as explained by Legrand, et. al. and Caes, et. al.

\* \* \* \* \*

### ***Response to Arguments***

Applicant's arguments filed 5 June 2008 have been fully considered but they are not persuasive.

1. Applicant argues that, "...a water content of even 2.5% does not make a composition anhydrous, as recited by the present claims." See remarks, page 4.

It is examiner's position that the 2.5% water content disclosed by Dias and the 1% instantly claimed are close enough that one skilled in the art would have expected them to have the same properties.

2. Applicant argues the facts of the *Titanium Metals* case do not apply to the instant application. See remarks, pages 4-5.

Examiner respectfully submits that the rule of *Titanium Metals* was applied to the rejection of record because the facts of *Titanium Metals* dealt with close but non-overlapping ranges, as is the case instantly.

3. Applicant argues that Dias discloses a broad range of diluent level. See remarks, page 5.

Examiner agrees that the disclosed range of diluent level is broad. However, Dias explicitly discloses non-aqueous formulations which contain very low levels of diluent, such as solid, powder, mascara, and paste (see col. 49, lines 34-36). Furthermore, Dias explains that, "...it is important that dyeing compositions be in a form which is easy and convenient to prepare and use by the consumer, since the oxidizing agent must remain in contact with the hair for a certain period of time and not run or drip off of the hair, possibly causing eye or skin irritation." See col. 49, lines 28-34; emphasis supplied. As such, examiner respectfully submits that while the disclosed range is broad, Dias provides specific disclosures of non-aqueous formulations containing *de minimus* water concentration.

4. Applicant argues that the rule of *In re Woodruff* does not apply when the claimed range and the range disclosed by the prior art do not overlap. See remarks, pages 5-6.

Examiner finds this argument persuasive.

5. Applicant argues that a proper inquiry in determining obviousness is directed to differences between the prior art and the claims in issue. See remarks, pages 6-7.

Examiner agrees with applicant that this is the proper inquiry. Examiner cited the disclosure of 5% to 35% polydecene in the instant specification (see page 8, paragraph

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041) as evidence that a person of ordinary skill in the art would expect the concentration of polydecene disclosed in the prior art to have the same properties as that being claimed.

6. Applicant argues that a person of ordinary skill in the art would not expect polydecene ranging from 15% to 35% by weight to be miscible within the aqueous compositions taught by Dias. See remarks, page 7.

As explained above, examiner respectfully submits that Dias explicitly discloses non-aqueous compositions such as solid, powder, mascara, and paste (see col. 49, lines 34-36). Concentrations of polydecene as high as 35% would be expected in such compositions.

7. Applicant argues, "...for a determination of obviousness, the disclosure of the prior art needs to be compared with the claims in issue, not the specification." See remarks, page 9.

As explained above, the disclosure of 5% to 35% polydecene in the instant specification (see page 8, paragraph 041) was cited as evidence that a person of ordinary skill in the art would expect the concentration of polydecene disclosed in the prior art to have the same properties as that being claimed.

\* \* \* \* \*

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

\*

This application contains claims 23-32 drawn to an invention nonelected with traverse in the reply filed on 24 July 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

★

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HASAN S. AHMED whose telephone number is (571)272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571)272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. S. A./  
Examiner, Art Unit 1618

/Humera N. Sheikh/  
Primary Examiner, Art Unit 1618